

3728 ~~AFS~~

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Merel Epstein Group Art Unit: 3728
Serial Number: 09/603,222 Examiner: Jila Mohandes
Filing Date: June 26, 2000
Title: **BALANCING APPLIANCE FOR FOOTWEAR ITEM**
Atty. Docket: EMR-100-A-1

TECHNOLOGY CENTER R3700

OCT 24 2001

RECEIVED



CERTIFICATE OF MAILING AND TRANSMITTAL LETTER

Hon. Commissioner of Patents
Box: Appeals
Washington, D.C. 20231

Sir:

Transmitted herewith is a Brief on Appeal (submitted in triplicate), Appendix to Brief on Appeal, Certificate of Mailing and Transmittal Letter and Self Addressed, Stamped Postcard.

- _____ No additional fee is required
- _____ Our Check in the amount of \$_____ is attached.
- X Charge **\$160.00** to Deposit Account No. 50-0404.
- X Please charge any additional fees or credit overpayment to Deposit Account No. 50-0404.

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Hon. Commissioner of Patents and Trademark, Washington, D.C. 20231 on this 15th day of October, 2001.

Karel Van Akin
Karel Van Akin



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Merel Epstein Group Art Unit: 3728
Serial Number: 09/603,222 Examiner: Jila Mohamed
Filing Date: June 26, 2000
Title: **BALANCING APPLIANCE FOR FOOTWEAR**
Atty. Docket: EMR-100-A-1

RECEIVED
OCT 24 2001
TECHNOLOGY CENTER R3700

#13/2
1/23/02

BRIEF ON APPEAL

Hon. Commissioner of Patents
Washington, D.C. 20231

Sir:

In connection with the Notice of Appeal filed August 13, 2001, please enter the following Brief on Appeal submitted pursuant to 37 CFR 1.92. The present Brief is being filed in triplicate.

I. REAL PARTY IN INTEREST

The Applicant, Merel Epstein, is the real party in interest.

II. RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences in connection with this application or any related application.

III. STATUS OF THE CLAIMS

Claims 1, 7 and 8, the only claims remaining in the application stand finally rejected pursuant to the Advisory Action of August 29, 2001.

10/23/2001 ABQND AF1 00000119 500404 09603222

01 FC:220 160.00 CH

However, the Office Action also failed to indicate whether or not the rejection under 35 U.S.C. 112 had been overcome as well as failing to indicate whether the amendment under 37 CFR 1.116 was entered for purposes of appeal. Thus, for purposes of this Appeal, it will be assumed that neither the rejection under 35 U.S.C. 112, nor the entry of the Amendment was effectuated.

IV. STATUS OF AMENDMENTS

An Amendment After Final Rejection was submitted. The Examiner indicated that the proposed Amendment would not be considered because it raised new issues that would require further consideration and/or search, but that the amendment did overcome the double patenting rejection.

As noted above, the Office Action did not indicate whether the Amendment would be entered for purposes of appeal. Thus, for purposes of this Appeal, it is assumed that the Examiner did not enter the Amendment.

V. SUMMARY OF THE INVENTION

The present invention is directed to a disc for use in conjunction with an orthotic device or footwear item for imparting proper balance and gait to a user. As disclosed at page 5, line 15 of the Specification, the disc hereof is a substantially circular, solid wedge member having a top or first surface, a second surface opposite the first surface, and a sidewall integrally formed therewith. The first surface is angularly inclined with respect to the second surface by an angle which ranges from about 2° to about 6°. As further taught at page 5 of the specification, in essence, the disc 16 defines a circular wedge or shim. Because

the disc is circular, it can be rotated through a 360° arc about a vertical axis to provide the minute adjustments prerequisite for imparting proper weight distribution and balance to the user.

The disc may be disposed directly on a footwear item, such as a shoe, or may be used in conjunction with an orthotic device, such as an insole or the like.

VI. ISSUES

A. Did the Examiner err in rejecting claim 1 and claims 7 and 8, as being vague and indefinite under 35 U.S.C. 112, second paragraph?

B. Did the Examiner err in holding claims 1 and claims 7 and 8, unpatentable under 35 U.S.C. 103 over *Kantro* in view of *Cherniak* alone or further in view of *Shaw*, *Smith* and *Marc*?

C. Did the Examiner err in not considering the Affidavit to be persuasive of patentability?

VII. GROUPING OF CLAIMS

Claim 1 defines a first grouping and claim 7 and 8 define a second grouping.

VIII. ARGUMENT

A. Did the Examiner err in rejecting claim 1 and claims 7 and 8, as being vague and indefinite under 35 U.S.C. 112, second paragraph?

In the Office Action of May 11, 2001, claims 1 and 7-8 were rejected as being indefinite because of the presence of the phrase, "the disc being securable to the orthotic foot device in a plurality of incremental orientations through 360°

to effect a desired balance and weight distribution.” This phrase appears only in claim 1. It was never present in claims 7 and 8. Therefore, it is inconceivable and improbable that this rejection could apply to claims 7 and 8. Claim 7 is an independent claim and claim 8 depends therefrom. Thus, it is submitted that the Examiner’s rejection of claims 7-8 under 35 U.S.C. 112, is and was wholly improper. If the Examiner had entered the Amendment of August 13, 2001, as to the rejection, it would have been overcome. Moreover, it is submitted that the rejection is in error.

Since the claims must be construed in the light of the specification, one of ordinary skill in the art could, with precision, understand the phraseology which is purportedly objectionable and the limitation imposed thereby. Thus, the Examiner is in error on both counts, i.e., failure to withdraw the rejection and the rejection, per se.

In propounding the rejection, the Examiner relied upon the *Danly* and *Hewlett-Packard* cases. While of interest, they are not believed relevant to the claims herein and the rejection under 35 USC Section 112, Paragraph 2. The relied upon passages from *Danly* (“apparatus claims cover what a device is, not what a device does”) and *Hewlett-Packard* (“apparatus claims cover what a device is, not what a device does”) are believed taken out of context or at best dicta.

Danly involved an appeal from the POBA of Claim 1, which claim was directed to a press structure in which “alternating current may be passed through the tie rod to heat same.” The CCPA noted that the quoted passage did

not constitute a structural limitation. That is not the case with the claims pending herein.

Hewlett-Packard (“H-P”) involved an appeal by Bausch & Lomb (“B&L”) from a decision upholding the validity and infringement of patent Claim 1, which claim was directed to an X-Y plotter system wherein one of a drive and idler surface had “a rough surface”. Although H-P disclosed the use of “grit”, the last clause of Claim 1 recited, “wherein the rough surface ... has a random pattern, size, and height of rough spots.” B&L argued that the recited phrase does not provide any “operational difference” over a knurled wheel (shown in the prior art) and thus does not render the claim unobvious thereover. In effect, B&L wanted to import a limitation into the claim from the specification onto claim language. The CAFC rejected B&L’s argument that H-P had to show “operational differences” of the claimed device over the prior art.

Independent Claim 1 is not properly rejected under either *Danly* or *Hewlett-Packard*. First, each of the elements required in each of Applicant’s claims, while having a specific structure and function, constitute definite structural limitations. As in *Hewlett-Packard*, the elements of the claims herein recite structure, which is used in a particular manner, albeit operating in a manner that is different from the prior art. The elements recited do not simply cover what the device does and the claim language is neither vague nor indefinite. Second, these structural limitations define over the references of record.

Accordingly, it is submitted that it has been established that the Examiner erred in this rejection and reversal thereof is respectfully requested.

B. Did the Examiner err in holding claims 1 and claims 7 and 8, unpatentable under 35 U.S.C. 103 over *Kantro* in view of *Cherniak* alone or further in view of *Shaw*, *Smith* and *Marc*?

Claims 1, and 7 – 8 stand rejected under 35 USC Section 103(a) as being unpatentable over *Kantro*, in view of *Cherniak*, *Shaw* (USPN 1,958,097), *Smith* (USPN 5,345,701, and *Marc* (USPN 5,068,983).

In Paragraphs 7 and 8 of the Action of May 11, 2001, the Examiner contends (at page 4) that *Kantro* '572 teaches substantially all the limitations of the claims, arguing that circular element 20 is of high density polymeric foam material and tapered at about 5 degrees, that *Cherniak* '267 teaches that foot balancing devices 50, 52, and 54 may be rigid or yieldable, and concludes that it would have been obvious to one having ordinary skill in the art and in view of *Cherniak* '267 to make the circular element 20 of *Kantro* '572 more rigid or sufficiently rigid to ensure better support and weight distribution.

The Examiner further contends on page 5 of the May 11, 2001 Action that *Shaw*, *Smith*, and *Marc* references are relied upon “for purposes of argument any doubt should subsequently be raised concerning the language in *Kantro* '572. ... These references both individually and collectively are representative of corrective wedge members having upper and lower surfaces angularly inclined by a small angle greater than zero (in the range of about 2 to 5 degrees) which are used with insoles and orthotics to enhance or correct biomechanical balance

and weight distribution.” In general, the Examiner contends that the orthotic disc can have a taper angle as desired and be secured to the insole with an orientation relative thereto as desired.

Applicant’s Attorney traverses both of the Examiner’s multi-reference rejections. Whether considering the references alone, or the combination of two references (*Kantro* and *Cherniak*), or the combination of five references (*Kantro*, *Cherniak*, *Shaw*, *Smith* and *Marc*), the references do not show, suggest, or provide a motivation for the combination proposed by the Examiner.

When prior art references require a selective combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself. Something in the prior art must suggest the desirability, and thus the obviousness, of making the combination. It is impermissible within the framework of 35 USC Section 103 to pick and choose from any one reference only so much of it as will support a given position to the full exclusion of other parts necessary for the full appreciation of what such reference fairly suggested to one of skill in the art.

The Examiner’s combination is a pure hindsight reconstruction of the prior art. Applicant’s Attorney submits that the prior art relied upon by the Examiner does not render Applicant’s claims obvious.

As will be developed more fully herein, the prior art does not render the claimed invention obvious under 35 USC Section 103(a) because the prior art:

(a) teaches away from a rigid circular wedge shaped disc member of the invention herein (Claims 1, and 7 - 8) by teaching the use of compressible cushions; and/or

(b) does not teach or suggest that the disc member (16) being securable to a desired location of a foot device and the wedge shape of the disc angularly oriented at any desired angle from 0° to 360° about a vertical axis through the center of the disc to effect a desired balance and weight distribution (Claim 1), or (2) have a specific angle of inclination of between 2° to 6° (Claims 7 and 8).

Inappropriateness of the reconstruction of *Kantro* with either or all of *Cherniak*, and *Smith*, and *Shaw*, and *Marc* is resolved in favor of nonobviousness, as supported by the “Affidavit Under 37 CFR 1.132” (the “Affidavit”) herein from one having twenty years of experience in the art, as discussed below.

Kantro, *Shaw*, *Smith* and *Marc* are all directed to cushions. A cushion can never impart balance. Applicant’s claimed invention is not a cushion but rather a rigid circular wedge-shaped orthotic device providing biomechanical control for balance.

As stated in the Affidavit, as understood by one having skill in the art, there is a difference between balancing a gait and cushioning. The word “cushion” implies a collapse of the structure or a flexure of the body of the device. A cushion is used to accommodate, rather than provide biomechanical control.

Kantro teaches that three specifically configured cushions (19, 20, and 21) be comprised of a polymeric foam material and be placed at specific locations (11,

12, and 13) of a shoe insert to form an obtuse triangle to provide tripodal support:

“As weight increases and its distribution on the body changes, more cushioning is required to lessen shock to the foot, also support at the gait points to permit the foot to maintain its proper posture as well as to alleviate stress and strain upward through the legs and into the lower back caused by improper foot posture.” (col. 4, lines 35 – 41)

Kantro teaches that more cushioning is required to lessen shock. This is consistent with the Affidavit - a cushion can never impart balance. Kantro does not teach and does not suggest the provision of a rigid circular member to provide control in balancing the gait of a user. Contrary to Claims 1, and 7 – 8 herein, Kantro teaches away from a rigid disc.

Further, in *Kantro*, the three locations (11, 12, and 13) of the shoe insert dictate the provision of three differently configured cushions (19, 20, and 21) and also requires that the geometry of each cushion (19, 20, and 21) have a specific angular orientation relative to the other discs and axes through the foot insert. In particular, *Kantro* teaches:

“To further mitigate the tendency towards pronation, cuboidal cushion 20 is also tapered alone (sic) an axis directed at an angle relative to the longitudinal axis of the insole along line 20a toward the gait point located at the base of the first metatarsal bone 9a and the metatarsal cushion 21. This corresponds to the direction of force along line 12a in FIG. (sic) from the calcaneal-cuboid gait point to the first metatarsal gait point 13.” (col. 4, lines 44 – 52)

The rotational positioning of cuboidal cushion 20 is such that the taper is angled relative to the longitudinal axis of the insert and the foot toward the base 13 of the first metatarsal bone 9a and the metatarsal cushion along line 20a.” (col. 5, lines 37 – 41)

Contrary to Claim 1, *Kantro* teaches against the provision of:

a substantially rigid, circular wedge-shaped member ... securable to the orthotic foot device at a desired location of said foot device and the wedge shape of the disc angularly oriented at any desired angle from 0° to 360° about a vertical axis through the center of the disc to effect a desired balance and weight distribution.

The orthotic disc of the claimed invention is securable to the foot insert at a desired location and angle relative to a vertical axis to effect a desired balance and weight distribution. *Kantro* teaches against the requirements of Claim 1.

Cherniak is directed to a foot balancing device comprising, inter alia, a first, second, and third set of circular pads (50, 52, and 54), each pad preferably being of uniform thickness, and, rigid or yieldable. (See FIG. 9, and col. 2, lines 1 –2, and col. 4, lines 6 – 9). *Cherniak* teaches:

“In all cases, the function of the pads is to lift the weight of the foot off the metatarsal heads so that the weight is balanced on the pads independently of the structural deformation of the skeletal foot and/or imbalance produced by callouses and the like on the bottom of the foot.” (col. 4, lines 6 – 9)

Cherniak does not teach provision of a wedge shaped orthotic disc to effect a desired balance and weight distribution.

In *Cherniak*, the pads are flat and circular and function to lift the weight of the foot. Indeed, *Cherniak* teaches that to achieve the lifting function, a continuous array of pads is required and that these pads be placed side-by-side. *Cherniak* certainly does not suggest that the pads be wedge shaped because the wedges with inclined faces would not provide the desired lifting function. Further, the orientation of the wedge-shapes in the array is not clear, as regards the effect on the foot. Clearly, *Cherniak* teaches against a wedge-shape pad that is oriented relative to a foot insert onto which secured.

The combination of *Kantro* in view of *Cherniak* is not believed to render Claim 1 obvious under 35 USC Section 103 (a). *Kantro* teaches against a rigid circular wedge shaped member, securable to a foot device at a desired location of the foot device and the wedge shape of the wedge shape of the disc oriented at any desired angle from 0° to 360° about a vertical axis through the center of the disc. To the extent that the *Kantro* disc (20) is tapered, the *Kantro* disc is not rigid, forms one vertex of an obtuse triangle and is fixed relative to the foot insert, and the wedge shape is aligned along an axis that is at an angle to the longitudinal axis of the insert. Notwithstanding the Examiner's combination of *Kantro* with *Cherniak*, *Kantro* teaches against incremental rotational angular positioning of the discs (19, 20, and 21) about a vertical axis through the disc from 0° to 360° to provide proper balance and weight distribution. Indeed, according to *Kantro*, "To further mitigate the tendency towards pronation, cuboidal cushion 20 is also tapered alone (sic) an axis directed at an angle relative to the longitudinal axis of the insole. As to the secondary reference, *Cherniak* teaches the provision of an array of pads of uniform thickness to provide a lifting function, the pads being rigid or yieldable. It is irrelevant how a flat circular disc of uniform thickness is oriented relative to a vertical axis therethrough.

At best, the combination of *Kantro* with *Cherniak* would provide a combination wherein the *Kantro* disc (20) is rigid, and of uniform thickness. To simply redesign the tapered disc (20) of *Kantro* in a vacuum is to ignore the teaching and function of the pads in either of the *Kantro* and *Cherniak*

references. A prior art reference that diverges from and points in a direction away from the invention is evidence that the invention is nonobvious and hence patentable.

Whether considered alone, or in combination, *Kantro* and *Cherniak* do not teach or suggest the requirements of Claim 1.

Accordingly, Claim 1, as amended is submitted as being patentable over the prior art references of *Kantro* and *Cherniak*.

As to the combination of *Kantro*, and *Cherniak*, and *Shaw*, and *Smith*, and *Marc*, the Examiner relied on these references as teaching the provision of wedge shaped members: *Shaw* for inclined wedge members having a tapered portion of about 3°, *Marc* for a base piece (20) having a tapered portion of 2°, and *Smith* for correcting wedges (24, 26) tapered at about 4°, concluding that the wedges can be formed at any angle, depending upon the patient's needs.

Applicant's Attorney traverses the Examiner's reliance on these references as being a hindsight reconstruction by using Applicant's claims as a roadmap to find prior art having a needed feature. Each reference had a specific problem and disclosed a specific solution.

Kantro fixes the locations, the geometries, and the angular orientations of three cushions relative to longitudinal axes passing through the foot device. The reason for the tripodal placement and cushion orientation was critical and particularly described by *Kantro*. *Kantro* was faced with a specific problem and disclosed a specific solution the Examiner's rejection required the addition of *Cherniak* – for a pad of uniform thickness. These references are then added to

show taper angles. The overall combination does not support a finding of obviousness under the factual mandates of 35 USC Section 103 (a).

Shaw, Marc and *Smith* do not show or suggest that a wedge-shaped orthotic disc that is positionable (i.e., angularly orientable) at any angle from 0° to 360° about a vertical axis through the disc. These references teach away from the wedge shaped corrective pads being circular or orientable through 360°, as required by Claim 1.

Shaw and *Smith* are similar in that each discloses wedge shaped corrective pads of rectangular configuration, a pad being secured, respectively, to the anterior and posterior portions of an insole and oriented such that each pad (and the tapered faces thereof) extend/face transversely of the longitudinal axis of the insole. *Marc* discloses a U-shaped heel element (20) that is similar to the cushion (19) of *Kantro*, the heel element (20) being inset into a like-shaped receiving cavity (11) in the foot element.

Applicant's Attorney submits that the Examiner has not properly followed the analysis required under 35 USC Section 103. The rejection is believed flawed because:

"Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so.' [ACS Hosp. Systems, Inc. v. Montefiore Hosp., 732 F. 2d 900, 1572, 1577, 221 USPQ 929, 933 (Fed. Cir 1984) Although couched in terms of combining teachings found in the prior art, the same inquiry must be carried out in the context of a purported "modification" of the prior art. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." *In re Fritsch*, 23 USPQ 2d 1780, 1783 (Fed. Cir. 1992).

Further, the mere fact that the prior art may be modified by in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.

Here, *Kantro* and *Cherniak* relied upon by the Examiner fail to suggest any motivation for, or the desirability of the changes espoused by the Examiner. The Examiner then picks and chooses elements from *Shaw*, and *Smith*, and then *Marc* to form an obviousness rejection.

The Examiner has relied upon hindsight to arrive at the determination of obviousness. The Examiner has impermissibly used the claimed invention as an instruction manual or “template” to piece together the teachings of the prior art so that the claimed invention is rendered obvious. The CAFC has made clear that “[o]ne cannot pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.” *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ 2d 1596, 1600 (Fed. Cir. 1988). Accordingly, the Examiner’s rejection based on a combination of *Kantro*, and *Cherniak*, and *Shaw*, and *Smith*, and *March* is believed contrary to the analysis required under 35 USC Section 103 and the rejection of the claims based on the above combination withdrawn.

Claims 7 – 8 are directed to balancing disc for balancing the gait of a user, and requires, inter alia,

a substantially rigid, circular, wedge member having a planar upper surface and a planar lower surface, the upper and lower surfaces being angularly inclined with respect to each other by an angle \emptyset of about 2° to about 6° the disc being attachable to a footwear item for imparting proper weight distribution and balance to the user.

Applicant's Attorney submits that the prior art does not teach the provision of a substantially rigid circular wedge-shaped member having an inclination range required in Claims 7 – 8.

Claims 7 – 8 require a substantially rigid circular wedge shaped disc. As discussed herein above, *Kantro* teaches the provision of cushions (19, 20, and 21), and *Cherniak* teaches pads of uniform thickness.

In *Kantro*, the cuboidal cushion (20) is shown (FIGS. 2, 3, and 5) as being circular and described as positioned “such that the taper is angled relative to the longitudinal axis of the insert”. Importantly, the Figures and the Specification do not state and do not show a taper angle of the cushion (20). The only angle that can be determined with any degree of certainty is the angle of the cushion (20) relative to the longitudinal axis of the foot. *Kantro* is silent as to a preferred angle or range of angles.

The Examiner states:

“[D]isc/cushion 20 can also be angularly tapered through its thickness from its forward edge rearward with respect to each other as described at column 4, lines 14-49 and column 5, lines 37-41. Note that heel cushion/disc 19 is **tapered** at about 5 degrees. It is submitted the only reasonable conclusion (by comparison of column 4, line 32 to line 46) is that cushion 20 is also exactly **tapered** as described for cushion/disc 19.”
Examiner's Action, lines 6 – 10 of Paragraph 8.

Applicant's Attorney strongly disagrees with the Examiner's contention as hindsight reasoning.

First, *Kantro* provides three cushions (19, 20, and 21) for three different gait points and arranges the cushions to form the vertices of an obtuse triangle. Each cushion has a **different geometry**, a **specific location**, a **specific**

orientation relative to longitudinal axes through the insole, and a **different function**. The cushions do not have the requisite geometry and the wedge shaped cushion (20) does not have the requisite angle of inclination.

Second, the Examiner's conclusion that the two cushions (19, and 20) have exactly the same taper, and that the taper angle is 5° is nowhere found in or suggested by *Kantro*. In *Kantro*, the heel cushion (19) is configured into a heel-shape for supporting the heel. *Kantro* teaches that heel cushion (19) is tapered through its thickness from its forward edge (19a) rearward, and that cuboidal cushion (20) is tapered along an axis at an angle relative to the longitudinal axis of the insole. *Kantro* does not state that the heel cushion (19) or the cuboidal cushion (20) be tapered at 5°, or at any range at all – only that each cushion be appropriately oriented relative to the other two cushions (20, and 21). The Examiner's assertion that "the only reasonable conclusion is that cushion (20) is also exactly tapered as cushion (19) [at about 5°]" is pure hindsight reading of *Kantro*. There is no teaching or suggestion in *Kantro* for the Examiner's conclusion.

The other references are of interest but further corroborative of the use of hindsight reading to pick and choose from different apparatus angles to support a rejection. The basic reference to *Kantro* and *Cherniak* do not show or suggest a disc as required by Claims 7 – 8. The secondary references to *Smith*, *Shaw*, and *Marc* are illustrative of picking and choosing that which is needed. While each apparatus may show an isolated structure that is tapered at a specific angle,

these reference do not show or suggest the requisite range as required in Claims 7 – 8.

Applicant's Attorney submits that Claims 7 – 8 are patentable over the prior art to *Kantro* and *Cherniak*, and/or in view of *Shaw*, and *Smith*, and *Marc*.

C. Did the Examiner err in not considering the Affidavit to be persuasive of patentability?

The Examiner contends that the Affidavit filed March 12, 2001 is insufficient to overcome the rejection of Claim 1 and Claims 7 and 8 based upon *Kantro*, *Cherniak*, *Shaw*, *Smith* and *Marc* as set forth in the Action (discussed herein below) because:

“Complementary anecdotes do not overcome evidence of anticipation and obviousness well established by the prior art. In view of the foregoing, when all of the evidence is considered, the totality of the rebuttal evidence of nonobviousness fails to overcome the evidence of obviousness.”

Applicant's Attorney disagrees with the weight afforded the Affidavit and the Examiner's characterization of the statements provided therein as being “anecdotes”.

The MPEP directs Examiner's to consider Affidavits from those skilled in the art opining that the prior art teaches away from the invention. Importantly, it is improper to combine references where the references teach away from the combination. *In re Gresselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983), MPEP Section 2145, page 2100-123 (Rev. 1, Feb. 2000).

The Affidavit herein presents the opinion of an Affiant having more than twenty (20) years experience in designing, selling and manufacturing orthotic

devices. Affiant is a highly experienced practitioner in the art of orthotics and the statements in the Affidavit are not merely anecdotes.

Affiant stresses that the invention herein is not a cushion, but rather, an insert that is made of a hard, rigid material that does not compress but which retains its shape to provide a biomechanical control for balance. All of the claims herein are directed to a balancing disc for securement to an orthotic device, the disc comprising a substantially rigid, circular wedge shaped member.

Affiant points out that to those skilled in the art of orthotics, there is a difference between balancing and cushioning. A cushion can never impart balance, as the word “cushion” implies a collapse of the structure or a flexure of the body of the device. A cushion is used to accommodate – not provide control.

The Examiner reconstructed *Kantro* with *Cherniak*, or with Marc, *Smith* and *Shaw*, to find Applicant’s claimed invention as being obvious under 35 USC Section 103. Affiant analyzed and distinguished the primary reference [*Kantro*] relied upon by the Examiner as follows:

“[*Kantro*] discloses a method for attaching cushions in specific locations to provide tripodal support ... to accommodate the foot, as opposed to applicant’s claimed invention which provides a hard, rigid, plastic material insert that provides a biomechanical control for balance.”

In short, *Kantro* teaches away from Applicant’s claimed invention.

Additionally, Affiant further distinguishes the invention and *Kantro*. First Affiant notes that the disc of the invention is capable of being rotated 360° such that the foot can be balanced by the eversion or inversion of the insole, by attachment of the inserts to the insole at any necessary locations to impart balance (see Claim 1). Note in *Kantro* that three differently configured discs (19,

20, and 21) are tripodally located at three different but specific locations and each configured disc disposed in a specific angular orientation relative to predetermined portions of the foot and relative to axes through the foot device. That is, *Kantro* teaches the provision of three differently configured discs (19, 20, and 21), and that each of the three discs be fixed spatially and angularly relative to the foot. *Kantro* teaches away from rotatingly adjusting the angular positioning of orthotic discs (19, 20, and 21), as desired or necessary.

Second, Affiant notes that the disc of the invention defines a circular wedge having an angle between upper and lower surfaces thereof within the range of 2° to 6° (see Claims 7 – 8). Affiant submits that *Kantro* discloses a wedge shaped circular cushion, but does not disclose or remotely suggest the 2° to 6° range of the balancing disc of the invention. This range provides a limitation to the angle of wedges and is capable of imparting balance to about 90% of the fore foot and rear foot encounters. In short, the importance of the range is not obvious.

Accordingly, Applicant's Attorney submits that the Examiner has not given the Affidavit herein the proper weight required to be given to rebuttal evidence of nonobviousness as detailed in the Declaration.

The Affidavit must be considered and given significant weight in the obviousness determination mandated by *Graham*. So considered, the Examiner's combination of references is thus seen as flawed.

CONCLUSION


The prior art of record herein, whether considered in view of *Kantro* in view of *Cherniak*, alone or further in combination with *Shaw*, *Smith*, and *Marc*, does not show or suggest or render obvious (a) the balancing disc for securement to an orthotic foot device, as required by Claim 1, or (b) the balancing disc for balancing the gait of a user, as required by Claims 7 and 8.

Applicant's Attorney submits that Claims 1, and 7 – 8 define patentably over the prior art, are allowable, and are in condition for allowance.

Further, Applicant submits that the rejection under 35 USC 112, second paragraph is improper.

Accordingly it is respectfully requested that the Examiner be reversed and that a Notice of Allowance be issued.

Respectfully Submitted,


Arnold S. Weintraub, Reg. No. 25523
PLUNKETT & COONEY, P.C.
38505 Woodward Avenue, Suite 3000
Bloomfield Hills, MI 48304
(248) 901-4043 – Direct Dial
(248) 901-4040 – Facsimile

Dated: Oct. 15, 2001

Blmfield.12452.03587.321345-1



Applicant: Merel Epstein Group Art Unit: 3728
Serial Number: 09/603,222 Examiner: Jila Mohandesi
Filing Date: June 26, 2000
Title: **BALANCING APPLIANCE FOR FOOTWEAR ITEM**
Atty. Docket: EMR-100-A-1

APPENDIX TO BRIEF ON APPEAL

1. A balancing disc for an orthotic foot device comprising:
a substantially circular member having a planar top surface and a planar bottom surface, the surfaces being inclined at an angle with respect to each other, the disc being securable to the orthotic foot device in a plurality of incremental orientations through 360° to effect a desired balance and weight distribution.

7. A balancing disc for balancing the gait of a user, comprising:
a substantially rigid, circular, wedge member having a planar upper surface and a planar lower surface, the upper and lower surfaces being angularly inclined with respect to each other by an angle θ of about 2° to about 6° the disc being attachable to a footwear item for imparting proper weight distribution and balance to the user.

8. The balancing disc of claim 7 wherein the disc is formed of a substantially non-compressible solid material selected from the group consisting of leather, rubber or plastic.